

## REMARKS

### **I. Status of Claims**

Claims 1-16, 18-19, and 25-29, 31, 33, 35, 37, and 39 are pending in the application. Claims 30, 32, 34, 36, and 38 are now canceled without prejudice to the subject matter therein.

Claim 29 stands rejected under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the written description requirement.

Claims 1, 2, 12, and 13 stand rejected under 35 USC §103(a) as being allegedly unpatentable over U.S. Pat. No. 3,991,750 to Vickery in view of U.S. Patent No. 5,302,201 to Lucke. Claim 3 stands rejected under 35 USC §103(a) as being allegedly unpatentable over Vickery in view of Lucke, further in view of U.S. Patent No. 4,489,026 to Yalkowsky. Claim 4 stands rejected under 35 USC §103(a) as being allegedly unpatentable over Vickery in view of Lucke, further in view of U.S. Pat. No. 4,581,242 to Forster. Claims 7, and 9-11 stand rejected under 35 USC §103(a) as being allegedly unpatentable over Vickery in view of Lucke, further in view of U.S. Pat. No. 4,586,457 to Dunajtschik. Claim 19 stands rejected under 35 USC §103(a) as being allegedly unpatentable over Vickery in view of Lucke, further in view of U.S. Pat. No. 3,696,188 to Fernandez et al. Claims 5-9, 12-16, 18, 25-28, 33, 35, 37, and 39 stand rejected under 35 USC §103(a) as being allegedly unpatentable over U.S. Pat. Pub. No. 2004/0261698 to Roorda et al., in view Forster and Schwarz. Claims 1, 30, and 31 stand rejected under 35 USC §103(a) as being allegedly unpatentable over Roorda, in view of U.S. Patent No. 4,581,242 to Forster and Schwarz, and in further view of Lucke.

The Applicants have carefully reviewed the June 20, 2006 final Office action. The Applicants are requesting entry of the foregoing amendments to place the claims in allowable condition.

For the reasons set forth in the following remarks, the Applicants believe that upon entry of the foregoing amendments, claims 1-16, 18-19, and 25-29, 31, 33, 35, 37, and 39 are in allowable form. The Applicants therefore respectfully requests reconsideration of the pending rejections and issuance of a Notice of Allowance.

## II. Rejections under 35 U.S.C. § 112

Claim 29 stands rejected under §112, 1<sup>st</sup> paragraph, as allegedly failing to comply with the written description requirement because it is “directed to a combination of spraying therapeutic from the channel positioned in the drum and tumbling an implant into a vat of therapeutic.” In response, the undersigned submits that the claim is amended and that any argued inadequacy of disclosure is irrelevant given the amendment. Reconsideration of the rejection is requested.

## III. Rejections under 35 U.S.C. § 103 and Request for Reconsideration

### a. *“reconfigurable medical implant”*

Independent claims 1, 7, 9, 12, 13, and 19 stand rejected under 35 U.S.C. §103(a) as being allegedly unpatentable over Vickery in view of Lucke.

The Applicant submits that claims 1, 7, 9, 12, 13, and 19 are at least patentable over the cited references because claims 1, 7, 9, 12, 13, and 19 now recite, a “...reconfigurable medical implant.” The Applicant respectfully submits that this language was previously considered by the Examiner in the February 8, 2006, Office Action when examining now canceled dependent claims 30, 32, 34, 36, and 38. Therefore, Applicant submits that amending the above-identified claims to recite “reconfigurable” does not raise new issues and should be considered by the Examiner.

For at least this reason, claims 1, 7, 9, 12, 13, and 19, as well as their dependent claims, are patentable over Vickery and Lucke.

### b. *“plurality of orifices”*

Claims 5-9, 12-16, 18, 25-28, 33, 35, 37, and 39 stand rejected under 35 USC §103(a) as being allegedly unpatentable over Roorda, in view Forster and Schwarz. Claims 1, 30,

and 31 stand rejected under 35 USC §103(a) as being allegedly unpatentable over Roorda, in view of U.S. Patent No. 4,581,242 to Forster and Schwarz, and in further view of Lucke.

The undersigned submits that independent claims 1, 5, 7, 9, 12, 13, 19, 25, and 29 are at least patentable over the cited references because they recite...a reconfigurable medical implant...and a drum having...a plurality of orifices. (emphasis added)

Regarding independent claims 1, 5, 7, 9, 12, 13, 19, 25, and 29, the Office action recognizes that Roorda does not teach or discuss this claim language. The Office action then contends that this deficiency may be satisfied by combining Roorda with Forster. The undersigned submits that this argument fails not only because there is no motivation to combine the references but also because this would change the principle of operation of Roorda, thus rendering it inoperative for its intended purpose. As stated in MPEP section 2143.01V, if a proposed modification would render the prior invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification.

As shown in FIGS. 2a-d, Roorda discloses a pan for coating stents with a coating substance comprised of an agent dissolved in a solvent. The pan is tilted at an acute angle for collecting coating substance between the bottom wall and side walls. The pan is also tilted and rotated for tumbling implants during the application of coating. After each coating repetition, solvent is removed following a waiting period so as to allow the liquid sufficient time to *flow and spread* over the stent surface. See ¶ 36. A waiting period of from about 0.1 second to about 20 seconds can be employed between solvent removal of one repetition and composition application of the subsequent repetition so as to ensure that the wetting rate of the coating composition is slower than the evaporation rate of the solvent within the composition, thereby promoting coating uniformity. See ¶ 39. Since the pan is tilted, at least in part, to collect coating substance, modifying the pan as suggested by the Office action would result in the coating substance *draining or leaking* from the pan. Loss of coating substance from the pan would result in non-uniform agent/solvent ratios from one cycle to the next, thereby rendering the device inoperative for its intended purpose, which is promoting coating uniformity.

There is also no suggestion or motivation of using Forster to modify Roorda to include side vents to allow air to blow up through a bed of objects as suggested in the Office

action. Since the pan is tilted, providing side vents on the Roorda pan would allow the coating substance to drain or leak and thus inhibit the uniform coating of the medical implant.

In addition, with respect to claim 25, compressible fluid is injected into the drums via the plurality of orifices to elevate and tumble the medical device. The rotation of the drum is not necessary. Roorda and Forster do not disclose or suggest elevating or tumbling a medical implant with a compressible fluid.

For at least these reasons, claims 1, 5, 7, 9, 12, 13, 19, 25, and 29 and their dependent claims are patentable over Roorda and the cited references.

#### IV. Conclusion

In view of the above amendments and remarks, it is believed that the above-identified application is in condition for allowance, and notice to that effect is respectfully requested. Should the Examiner have any questions, the Examiner is encouraged to contact the undersigned at the telephone number indicated below.

The Commissioner is authorized to charge any fees or credit any overpayments which may be incurred in connection with this paper under 37 C.F.R. §§ 1.16 or 1.17 to Deposit Account No. 11-0600.

Respectfully submitted,

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